

REMARKS / ARGUMENTS

The present application includes pending claims 1-30, claims 1-7, 9-17, 19-27, 29 and 30 have been rejected. Claims 8, 18 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. By this Amendment, claims 8, 18 and 28 have been withdrawn without prejudice or disclaimer to the subject matter therein, and new claims 31, 32, and 33 have been added. The Applicants respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1, 9, 11, 19, 21, and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 5,648,992, issued to Wright, et al. ("Wright"). Claims 2, 4, 6, 12, 14, 16, 22, 24, and 26 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over Wright in view of U.S. Patent No. 5,787,122, issued to Suzuki ("Suzuki"). Claims 3, 13, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Suzuki, and further in view of U.S. Patent No. 6,922,549, issued to Lyons, et al. ("Lyons"). Claims 5, 15, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Suzuki, and further in view of U.S. Patent No. 5,481,571, issued to Balachandran, et al. ("Balachandran"). Claims 7, 17, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Suzuki, and further in view of Lyons. Claims 10, 20, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Suzuki, and further in view of U.S. Patent No. 6,002,672, issued to Todd ("Todd"). The Applicants respectfully traverses these rejections at least for the following reasons.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

I. Wright Does Not Anticipate Claims 1, 11, and 21

The Applicants first turns to the rejection of claims 1, 11, and 21 under 35 U.S.C. 102(e) as being anticipated by Wright. With regard to the anticipation rejections under 102(e), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[i]f the identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

Wright discloses "a method for combining antenna diversity and gain control in a communications system using a single chain of receiver electronics." See Wright at Abstract.

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102 (e)

With regard to the rejection of independent claim 1 under Wright, the Applicant submits that Wright does not disclose or suggest at least the limitation of "selecting for signal processing a portion of said dwelled-on at least one of a plurality of antennas **based on said determined gain and said determined at least one of a plurality of signal quality metrics** from said dwelled-on at least one of a plurality of antennas," as recited by the Applicant in independent claim 1 (emphasis added).

The Office Action refers for support to Figures 3 and 4 of Wright, as well as column 4, line 65 – column 5, line 21 of Wright. See the Office Action at page 2. The Applicants respectfully disagree. Wright discloses the following:

Switch 14 couples either the first antenna 10 or the second antenna 12 to the receiver electronics depending upon the diversity control indicator 29 which is an input to switch 14. A signal transmitted from a portable handset is received by the selected antenna and passed to the gain control switch 18 by switch 14. Depending upon the gain control indicator 28, the gain control switch 18 selects one of three gain paths 15, 19 or 17. In particular switch 18 is configured to receive the gain control indicator 28 and select either the gain path 15, the no gain path 19, or the attenuation path 17. (emphasis added)

See Wright at col. 4, lines 21-31. In this regard, Wright discloses that the switch 14 selects between antenna 10 or antenna 12 based only on diversity control indicator 29. The diversity control indicator, however, is based on the received signal data, frequency variance, timing variance and RSSI. See Wright, col. 4, lines 65-67. Furthermore, gain

information within the base station receiver structure disclosed by Wright in Figure 3 is relevant only with regard to switch 18, i.e., only after an antenna has been selected by switch 14. For example, based on the gain control signal 28, the signal from the selected antenna is amplified, attenuated, or left unchanged as it passes through gain paths 15, 17, or 19, respectively. See *id.* at Figure 3 and col. 4, lines 21-31. Therefore, Wright does not disclose or suggest the limitation of "selecting for signal processing a portion of said dwelled-on at least one of a plurality of antennas based on said determined gain and said determined at least one of a plurality of signal quality metrics from said dwelled-on at least one of a plurality of antennas," as recited by the Applicant in independent claim 1 (emphasis added).

Accordingly, independent claim 1 is not anticipated by Wright and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 9, 19, and 29

Based on at least the foregoing, the Applicants believe the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Wright has been overcome and request that the rejection be withdrawn. Additionally, claims 9, 19, and 29 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-30.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Prior Art Does Not Render Claims 2-7, 10, 12-17, 20, 22-27, and 30 Unpatentable

Based on at least the foregoing, the Applicants believe the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Wright has been overcome and request that the rejection be withdrawn. Additionally, since the additional cited references (Suzuki, Lyons, Balachandran, and Todd) do not overcome the deficiencies of Wright, claims 2-7, 10, 12-17, 20, 22-27, and 30 depend from independent claims 1, 11, and 21, and are, consequently, also respectfully submitted to be allowable.

Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-30.

CONCLUSION

The Applicants have withdrawn claims 8, 18, and 28, and respectfully submit that new claims 31, 32, and 33 correspond to claims 8, 18, and 28 rewritten in independent form including all of the limitations of the base claim and any intervening claims and are in condition for allowance. Based on at least the foregoing, the Applicants believe that all remaining claims are also in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8232.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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